

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO. 16/969,802	FILING DATE 11/15/97	FIRST NAMED INVENTOR BAWENDI	ATTORNEY DOCKET NO. M
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MARY ROSE SCOZZAFAVA  
CHOATE HALL & STEWART  
EXCHANGE PLACE  
53 STATE STREET  
BOSTON MA 02109

IM32/0512

LE, H

EXAMINER

ART. UNIT 1773	PAPER NUMBER
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DATE MAILED:

05/12/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/969,302</b>	Applicant(s) <b>Bawendi et al</b>
	Examiner <b>H. Thi Le</b>	Group Art Unit <b>1773</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) 15-23 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-14 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 & 7

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1773

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a nanocrystal, classified in class 428, subclass 402.
- II. Claims 15-23, drawn to a method, classified in class 205, subclass 124.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another materially different process such as nucleating growth to form the core of monodisperse particle population and passivation to form the coating.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Applicant's representative, Mr. Sam Pasternack on May 4, 1999, a provisional election was made with traverse to prosecute the invention of group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1773

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kortan et al ("Nucleation and Growth of CdSe on ZnS Quantum Crystallite Seeds, and Vice Versa, in Inverse Micelle Media," Journal of the American Chemical Society, Vol. 112, 1990, pp. 1327-32).

Kortan et al disclose the growing of ZnS on a CdSe forming a crystallite nanostructure. Because CdSe is a seed, its particle population is inherently monodisperse. See abstract. The overcoating of ZnS though not continuous is uniform. See page 1332, right column, fourth full paragraph.

Claim 10 - p. 1329, right column, last paragraph, et seq.

Claims 11-14 - see p. 1327, left column.

Art Unit: 1773

Other properties as claimed in claims 2-10 are considered inherent because the same coated nanocrystal consisting of the same core and overcoating layer formed by the process of Kortan as claimed.

7. References are cited as art of interest.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *H. Thi Le* whose telephone number is (703)308-2415. The examiner can normally be reached on Mondays through Fridays from 8:30 a.m. to 5:00 p.m. The fax phone number is (703) 305-5436.

May 5, 1999

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*H. Thi Le*  
PRIMARY EXAMINER  
ART UNIT 1773

Art Unit: 1773

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